

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: WANG ET AL.)
)
Serial No.: 10/506,418)
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Filed: 02/26/2003)
)
For: BIODEGRADABLE MATERIALS)
FROM STRACTH-GRAFTED POLYMERS)
)
Art Unit: 1711)
)
Examiner: OLGA ASINOVSKY)

REQUEST FOR COMPLETION OF OFFICE ACTION PURSUANT TO MPEP § 710.06

Mail Stop Amendment
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to MPEP § 710.06, Applicant calls to the attention of the Office the errors in the Office's paper of June 22, 2007, and requests (a) that the Office reissue the paper in corrected and completed form, and (b) reset the period for reply to one month from the date of the corrected Office paper.

MPEP § 710.06 was recently amended to provide as follows, in relevant part:

710.06 Situations When Reply Period Is Reset or Restarted

Where the citation of a reference is incorrect or an Office Action contains some other error that affects applicant's ability to reply to the Office Action and this error is called to the attention of the Office within 1 month of the mail date of the action, the Office will restart the previously set period for reply to run from the date that the error is

corrected, if requested to do so by Applicant. If the error is brought to the attention of the Office within the period of reply set in the Office action but more than 1 month after the date of the Office action, the Office will set a new period for reply, if requested to do so by the Applicant, to substantially equal the time remaining in the reply period. For example, if the error is brought to the attention of the Office 5 weeks after mailing the action, then the Office would set a new 2 month period for reply. The new period for reply must be at least 1 month and would run from the date the error is corrected. See MPEP § 707.05(g) for the manner of correcting the record where there as been an erroneous citation.

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A supplementary action after a rejection explaining the references more explicitly or giving the reasons more fully, even though no further references are cited, establishes a new date from which the statutory period runs.

I. The Office's Papers are Incomplete on Section 103 issues.

Applicant brings to the Office's attention the following specific errors, and requests that the Office Action be corrected and reissued. The date for reply should be set to at least one month from the date of the corrected action.

On page 3, paragraph 4, the Office Action rejects Claims 1-18 under 35 U.S.C. §103(a) as being unpatentable over Dehannav et al. (U.S. Patent No. 5,510,401) or Willet et al. (U.S. Patent No. 6,054,510). The Examiner goes on to discuss the subject matter of the Dehannav et al. reference, however, fails to provide any guidance as to the rejection under Willet. Because the Examiner fails to discuss the particular facts or subject matter disclosed by Willet, thus making the Office Action too vague as to the Willet reference to identify any specific issues, it is impossible for the Applicant to reply.

II. Motivation to Combine and Reasonable Expectation of Success

The June 22, 2007 paper offered Examiner argument for "motivation to combine," but cited no substantial evidence. The showing of "motivation to combine" identifies no particular evidence, either to show that the particular problems discussed in the Office Action or the particular solutions were known. "Motivation to modify" appears to be based entirely on the

Examiner's personal knowledge or speculation. Pursuant to 37 C.F.R § 1.104(d)(2), Applicant calls for a reference or affidavit in support of any statement of "motivation to combine." The "particular portion relied on" must be "designated as nearly as practical." § 1.104(c)(2).

On the current state of the record, it appears that motivation to combine arises from nothing more than the Examiner's hindsight, because no particular language of any particular document, especially in Willet, has been identified. Because of this omission and failure to provide specific evidence in support of motivation to combine, Applicant is unable to reply. Kindly provide a specific citation to substantial evidence to support "motivation to combine," or withdraw the combination.

MPEP §§ 2142 and 2143.03 require a showing of "reasonable expectation of success" for any obviousness of rejection. This serves as a check against combining things in an impossible way. The Office Action has made no showing of "reasonable expectation of success," and no rejection exists until such a showing is made. Until a showing of "reasonable expectation of success" is stated, no reply is possible.

III. CONCLUSION

Applicant requests a corrected Office Action. If no such Action can be prepared that rejects Claims, Applicant requests that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned attorney at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. Kindly charge any addition fee, or credit any surplus, to Deposit Account No. 081500.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Shawn M. DeHegar", enclosed within a large, loopy oval shape.

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